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PATENT & TRADEMARK OFFICE
IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sandra L. Standiford, et al.

Confirmation No.: 5929

Application No.: 09/368,792

Examiner: T. Q. Tran

Filing Date: August 5, 1999

Group Art Unit: 2616

Title: VIDEO DATA CONVERSION MECHANISM

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 12, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- | | |
|------------------|-----------|
| () one month | \$120.00 |
| () two months | \$450.00 |
| () three months | \$1020.00 |
| () four months | \$1590.00 |

() The extension fee has already been filled in this application.

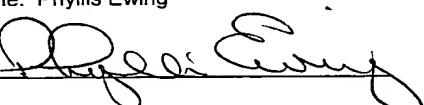
(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

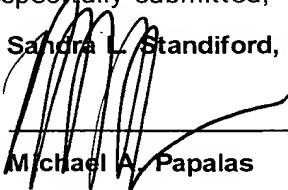
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I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop AF, Director for Patents, Alexandria, VA 22313-1450.

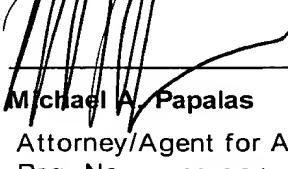
Typed Name: Phyllis Ewing

Signature: 

Respectfully submitted,


Sandra L. Standiford, et al.

By


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O I P E
JUL 12 2005
PENT & TRADEMARK OFFICE
HEWLETT-PACKARD COMPANY
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Fort Collins, Colorado 80527-2400

PATENT APPLICATION
ATTORNEY DOCKET NO. 10981001-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sandra L. Standiford et al.

Application No.: 09/368,792

Confirmation No.: 5929

Filed: August 5, 1999

Art Unit: 2616

For: VIDEO DATA CONVERSION MECHANISM

Examiner: T. Q. Tran

APPEAL BRIEF UNDER C.F.R. § 41.37

MS Appeal Brief - Patents
Director for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

As required under 37 C.F.R. § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on May 12, 2005, and is in furtherance of said Notice of Appeal.

The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- Appendix A Claims

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principle place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 22 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-22
4. Claims allowed: None
5. Claims rejected: 1-22

C. Claims On Appeal

The claims on appeal are claims 1-22

IV. STATUS OF AMENDMENTS

Appellant did not file an Amendment after the Final Office Action mailed on February 25, 2005 (hereinafter the "Final Action"). As such, claims 1-22 are pending as submitted in the Amendment In Response to the Non Final Office Action filed on October 7, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The summary is set forth in several exemplary embodiments that correspond to claims 1, 2, 10 and 19. Discussions about elements and recitations of these claims can be found at least at the cited locations in the specification and drawings.

According to claim 1, the apparatus for converting analog video data into digital form comprises an analog video cassette player for producing analog video output (figure 1, 10,11, 12; pg. 5, 1st paragraph; pg. 5, 2nd paragraph), an analog to digital converter for converting said analog video output into digital data (pg. 6, 1st paragraph), and at least one recorder employing a digital storage medium for storing said digital data (figure 1, 13, 14; pg. 5, 3rd paragraph; pg. 5, 4th paragraph). Further, according to claim 1, the cassette player, converter, and storage medium are disposed within a single container (see figure 1, 10) wherein said digital storage medium is insertable into and removable from said container (see figure 1, 13; pg. 5, 3rd paragraph), and a key frame marker for inserting at least one marker into the digital data (pg. 6, 2nd paragraph).

According to claim 2, the apparatus for converting analog video data into digital form further comprises a video port of receiving analog video information for an external source (pg 5, 2nd paragraph).

According to claim 10, the method for preserving analog video data in digital form comprises the steps of providing a container (see figure 1, 10), producing analog video output from an analog video tape in said container (figure 1, 11, 12; pg. 5, 1st paragraph), and converting said analog video output into digital video data in said container (pg. 6, 1st paragraph). Claim 10 also includes inserting a removable digital storage medium into said container (figure 1, 13, 14; pg. 5, 3rd paragraph) and storing said digital video data in said digital storage medium in said container (pg. 5, 3rd paragraph).

According to claim 19, the apparatus for preserving analog video data in digital form comprises a video cassette player for producing analog video output from an inserted video cassette (figure 1, 11, 12; pg. 5, 1st paragraph), an analog to digital converter for converting said analog video output into digital data thereby protecting said data against degradation of over time (pg. 6, 1st paragraph), and one of a CD recorder and a DVD recorder for storing

said digital data onto at least one inserted digital storage medium (see figure 1, 13, 14; pg. 5, 1st paragraph; pg. 5, 3rd paragraph), thereby transferring said analog video from said inserted cassette to said inserted digital medium (pg. 5, 3rd paragraph). Further, according to claim 19, the video cassette player, analog to digital converter, and digital storage medium are disposed within a single container (see figure).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 3-22 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,446,599 issued to Lemelson (hereinafter “*Lemelson*”).

Whether claim 2 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lemelson* in view of U.S. Patent No. 6,052,508 issued to Mincy et al (hereinafter “*Mincy*”).

VII. ARGUMENT

Claims 1, 3-22 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lemelson* alone. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); M.P.E.P § 2143. Without conceding the first or second criteria, Appellant asserts that the rejection does not satisfy the third criteria.

Lack of All Claim Limitations

Claim 1

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *Lemelson* does not teach or suggest all the limitations of claim 1.

Claim 1 requires an analog **video cassette player** for producing analog video output. Claim 1 then requires an analog to digital converter for converting the analog video output, **produced by the video cassette player**, into digital data. *Lemelson* does not teach or suggest this limitation. The Examiner cites *Lemelson* as disclosing “an analog to digital converter for converting said analog video output into digital.” (Final Action pg 3). Specifically, the Examiner points to *Lemelson*, at col. 7 lines 10-18, for teaching an analog to digital converter as recited in claim 1, Appellant respectfully disagrees. This section of *Lemelson* discloses “an analog-to digital converter 71 [receiving input sweep signals generated by Sweep signal generator 65], the output digital signals of which are passed to an address pointer 72.” (*Lemelson* col. 7, lines 10-13). Nowhere does Lemelson teach or suggest an analog to digital converter for converting the analog video output, **produced by the video cassette player**, into digital data. Instead Lemelson teaches and suggests an analog to digital converter for converting analog information from a sweep generator (not a video cassette player) into digital data.

Claim 1 also recites “at least one recorder employing a digital storage medium for storing said digital data, wherein said cassette player, said converter and said storage medium are disposed within a single container wherein said digital storage medium is insertable into and removable from said container.” (emphasis added). The Examiner points to *Lemelson*, at col. 12 lines 25-38, as disclosing “at least one recorder employing storage medium for storing the video data,...wherein said storage medium is inserted into and removable from said container.” (Final Action pg 3). Appellant respectfully disagrees. This section of *Lemelson* discloses “a solid state memory 133 which may be connected, as shown, by means of pluggable contacts....For recording, memory 133 is connected...by means of plug contact 138.” (*Lemelson* col. 12, lines 26-31). The Examiner’s own citation makes clear that *Lemelson* discloses only a memory that may be *plugged into*, but not disposed within or inserted into, “the container.” According to the Examiner’s own contention, *Lemelson* discloses only a memory always remaining peripheral to, but not disposed within or insertable into, “the container.” As such, nowhere does *Lemelson* teach or suggest that the cassette player, the converter, and the storage medium are disposed within a single container wherein the digital storage medium is insertable into and removable from the container.

Claims 2-9 depend from independent claim 1 and thus inherit all limitations of claim 1. Each of claims 2-9 set forth features and limitations not recited by Lemelson. Thus, the Appellant respectfully asserts that for at least the reasons set forth above, claims 2-9 are patentable over the 35 U.S.C. § 103 rejection of record.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Toyka*, 490 F.2d 981, 180 USPO 580 (CCPA 1974). *Lemelson* does not teach or suggest all the limitations of claim 10.

Claim 10 recites producing analog video output from an analog video tape in the container. The claim then recites converting the analog video output, **produced by the analog video tape**, into digital video data in the container. The Examiner simply states “the method of claim 10 is rejected for the same reasons discussed in apparatus claim 1 above.” (Final Action pg 6). Therefore, the Appellant can respond to the Examiner’s argument only by reiterating that the Examiner, at least in rejecting claim 1, has failed to show *Lemelson* discloses Appellant’s claimed limitations. Again *Lemelson* discloses “an analog-to digital converter 71 [receiving input sweep signals generated by Sweep signal generator 65], the output digital signals of which are passed to an address pointer 72.” (*Lemelson* col. 7, lines 10-13). In other words, the section of Lemelson cited by the Examiner teaches an analog to digital converter for converting analog information from a sweep generator (not an analog video tape) into digital data. Nowhere does Lemelson teach or suggest producing analog video output **from an analog video tape** and then converting the analog video output into digital video data.

Claim 10 further requires the steps of “inserting a removable digital storage medium into said container and storing said digital video data in said digital storage medium in said container.” *Lemelson* does not teach or suggest these limitations. The Examiner points to *Lemelson*, at col. 12 lines 25-38 for teaching these limitations. Appellant respectfully disagrees. This section of *Lemelson* discloses “a solid state memory 133 which may be connected, as shown, by means of pluggable contacts....For recording, memory 133 is connected...by means of plug contact 138.” (*Lemelson* col. 12, lines 26-31). The Examiner’s own citation makes clear that *Lemelson* discloses only a memory that may be *plugged into*, but not disposed within or inserted into, “the container.” According to the Examiner’s own

contention, *Lemelson* discloses only a memory always remaining peripheral to, but not disposed within or insertable into, “the container.” As such, nowhere does *Lemelson* teach or suggest inserting a removable digital storage medium into the container and storing the digital video data in the digital storage medium in the container.

Claims 11-18 and 21 depend from independent claim 10 and thus inherit all limitations of claim 10. Each of claims 11-18 and 21 set forth features and limitations not recited by *Lemelson*. Thus, the Appellant respectfully asserts that for at least the reasons set forth above, claims 11-18 and 21 are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 19

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPO 580 (CCPA) 1974). *Lemelson* does not teach or suggest all the limitations of claim 19.

Claim 19 requires an analog to digital converter for converting said analog video output, **produced by a video cassette player**, into digital data thereby protecting said data against degradation of over time. The Examiner simply states “claim 19 is rejected for the same reasons as discussed in claims 1 and 4-5 above.” (Final Action pg 7). Therefore, the Appellant can respond to the Examiner’s argument only by reiterating that the Examiner, at least in rejecting claims 1 and 4-5, has failed to show *Lemelson* discloses Appellant’s claimed limitations. *Lemelson* discloses “an analog-to digital converter 71 [receiving input sweep signals generated by Sweep signal generator 65], the output digital signals of which are passed to an address pointer 72.” (*Lemelson* col. 7, lines 10-13). Nowhere does *Lemelson* teach or suggest an analog to digital converter for converting the analog video output, **produced by the video cassette player**, into digital data. Instead, *Lemelson* teaches and suggests an analog to digital converter for converting analog information from a sweep generator (not a video cassette player) into digital data.

Claim 19 further recites “one of a CD recorder and a DVD recorder for storing said digital data onto at least one inserted digital storage medium...wherein said video cassette player, said analog to digital converter, and said digital storage medium are disposed within a single container.” Nowhere does *Lemelson* teach or suggest these limitations. Again, as

pointed out by the Examiner, *Lemelson* discloses a memory that may be plugged into, but is not disposed within, a container. (*See Lemelson* col. 12, lines 26-31).

Claims 20 and 22 depend from independent claim 19 and thus inherit all limitations of claim 19. Each of claims 20 and 22 set forth features and limitations not recited by *Lemelson*. Thus, the Appellant respectfully asserts that for at least the reasons set forth above, claims 20 and 22 are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 2

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lemelson* in view of *Mincy*. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first or third criteria.

Lemelson, as discussed above, does not teach “an analog to digital converter for converting said analog video output [from an analog video cassette player] into digital data.” Also as discussed above, *Lemeslon* fails to teach “at least one recorder employing a digital storage medium for storing said digital data, wherein said cassette player, said converter and said storage medium are disposed within a single container wherein said digital storage medium is insertable into and removable from said container.” *Mincy* is not relied upon to teach these missing limitations. Therefore, for at least the reasons given above in connection with independent claim 1, the combination of *Lemelson* and *Mincy* fails to teach or suggest each of the limitations in claim 2.

However, claim 2 additionally requires “a video port.” A video port is a specific structure for receiving analog video information from an external source. The Examiner relies upon *Mincy* to teach the recited “video port.” (*see Final Action pg 8, paragraph 6*). The Examiner states Mincy teaches “an EXT key for selecting external video” and that “it would have been obvious ... to incorporate the ‘EXT’ key as taught by Mincy et al into Lemelson’s

system in order to increase the flexibility of the system of Lemelson..." (Final Action pg 8). Appellant respectfully disagrees. *Lemelson* discloses "[that] the EXT key...selects external video rather than camera as the source for either program output, monitor output or recording or insertion as an event." (*Lemelson* col. 17, lines 61-64). However, an EXT key, simply pointed out as a button or toggle in *Lemelson*, is plainly not a video port. Therefore, Appellant respectfully asserts that Examiner's proposed combination fails to teach each of Appellant's claimed limitations.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Appellant on October 7, 2004.

IX. EVIDENCE

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS

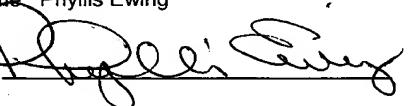
No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Dated: July 12, 2005

Respectfully submitted,

"Express Mail" label no. EV 629197994 US
Date of Deposit: 07/12/2005
I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop AF, Director for Patents, Alexandria, VA 22313-1450.

Typed Name: Phyllis Ewing

Signature: 

By _____
Michael A. Papalas
Registration No.: 40,381
(214) 855-8186
Attorney for Appellant

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/368,792

1. Apparatus for converting analog video data into digital form, the apparatus comprising:
 - an analog video cassette player for producing analog video output;
 - an analog to digital converter for converting said analog video output into digital data;
 - at least one recorder employing a digital storage medium for storing said digital data, wherein said cassette player, said converter and said storage medium are disposed within a single container wherein said digital storage medium is insertable into and removable from said container; and
 - a key frame marker for inserting at least one marker into the digital data.
2. The apparatus of claim 1, further comprising:
 - a video port for receiving analog video information from an external source.
3. The apparatus of claim 1, wherein the video cassette player employs a VHS format.
4. The apparatus of claim 1, wherein the digital storage medium is one of a CD R or a CD RW.
5. The apparatus of claim 1, wherein the digital storage medium is a recordable DVD.
6. The apparatus of claim 1, wherein the digital storage medium is selectable by the user.
7. The apparatus of claim 1, further comprising:
 - wherein the a key frame marker for marking marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence.
8. The apparatus of claim 1, further comprising: wherein the a key frame marker for marking marks positions in a sequence of said digital data at selectable time intervals.

9. The apparatus of claim 1, wherein the video cassette player employs the 8 mm format.

10. A method for preserving analog video data in digital form, the method comprising the steps of:

providing a container;
producing analog video output from an analog video tape in said container;
converting said analog video output into digital video data in said container;
inserting a removable digital storage medium into said container; and
storing said digital video data in said digital storage medium in said container.

11. The method of claim 10 comprising the further step of:

determining a required digital storage format prior to said step of converting based upon detection of a format of said inserted storage medium.

12. The method of claim 10 comprising the further step of:

inserting at least one marker in said digital video data to identify abrupt changes in video scenery, thereby enabling a user to readily identify particular video sequences during playing of said digital video data.

13. The method of claim 10, comprising the further step of:

inserting at least one marker in said digital video data at selectable time intervals, thereby enabling a user to readily move to selected chronological points in a video sequence during playing of said digital video data.

14. The method of claim 10, wherein the digital storage medium is one of CD R or CD RW.

15. The method of claim 10, wherein the digital storage medium is a recordable DVD.

16. The method of claim 10, wherein the digital storage medium is digital tape.

17. The method of claim 10, wherein the analog video tape is in VHS format.

18. The method of claim 10, wherein the analog video tape is in 8 mm format.

19. Apparatus for preserving analog video data in digital form, the apparatus comprising:

a video cassette player for producing analog video output from an inserted video cassette;

an analog to digital converter for converting said analog video output into digital data thereby protecting said data against degradation of over time; and

one of a CD recorder and a DVD recorder for storing said digital data onto at least one inserted digital storage medium, thereby transferring said analog video from said inserted cassette to said inserted digital medium, wherein said video cassette player, said analog to digital converter, and said digital storage medium are disposed within a single container.

20. The apparatus of claim 19, further comprising:

a key frame marker for inserting index markers in said digital data marking abrupt changes in video image sequences, and alternatively, at selectable time intervals.

21. The method of claim 10, further comprising:

removing the digital storage medium from said container after storing said digital video data in said digital storage medium.

22. The apparatus of claim 19 wherein the digital storage medium is insertable into and removable from said single container.